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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/333,095 06/15/99 KNIGHT

C NVI-5044

000321 IM62/0410
SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS MO 63102

EXAMINER

BHAT,N

ART UNIT

PAPER NUMBER

1761

DATE MAILED:

04/10/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/333,095

Applicant(s)

KNIGHT ET AL.

Examiner

N. Bhat

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2000.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) _____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 14) ☐ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 17) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other:

DETAILED ACTION

1. Applicant's amendments and comments have been fully and carefully considered. Applicant's representative was contacted by the Examiner on several occasions by telephone to indicate the only issue remaining in the case is the timely filing of a terminal disclaimer which applicant's representative has asked the office to hold the request for Terminal Disclaimer over co-pending application Serial no. 08/900,414 in abeyance. Applicant's Rep. did not respond to the examiner's communications. It is acknowledged that claims 12-19 have been added.

2. Applicant is advised that on page 6 of the specification, line 27 the hyperlink [HTTP://www.inform.umd.edu](http://www.inform.umd.edu) is impermissible incorporation by reference. See MPEP 608.01 (p), paragraph I. Applicant is kindly requested to delete this reference in the specification. If the hyperlink and/or other forms of browser-executable codes are part of applicant's invention and are necessary to be included in the patent application in order to comply with requirements of 35 U.S.C. 112, first paragraph, and applicant does not intend to have these hyperlinks to be active applicant should advise the examiner if this is the case. If the hyperlink is required for 112, 1st reasons, the office will disable these hyperlinks when preparing the patent text to be loaded onto the PTO web database.

3. Regarding the computer program DAIRYLP AND CNCPS, applicant is requested to inform the Office whether this program is copyright protected. If either of these computer programs are copyright protected then the claim would be rejected and would

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require appropriate correction which would applicant can do by avoiding the recitation of the specific computer program.

4. Claims 1-11 remain rejected and claims 12-19 are rejected under the judicially created doctrine of double patenting over claims 1-12 of U. S. Patent No. 6017563 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A process for formulating a ruminant food ration comprising the steps of determining the methionine needs of the ruminant, identifying a plurality of natural or synthetic feed ingredients and the nutrient composition of each of the ingredients where one of the ingredients is a hydroxy analog of methionine, specifically 2-hydroxy-4-(methylthio) butanoic acids or its salts or its amines or its esters thereof. To use applicant's specific 2-hydroxy-4-(methylthio)butanoic acids analogs from a broad recitation of hydroxy analogs of methionine selected from the group consisting of 2-hydroxy-4-(methylthio) butanoic acids, salts, amines and esters thereof overlap in scope and are claiming common subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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5. Applicant is again caution that when reading the Markush group of claim 1 and reading claim 1 and 2 US Patent 6017563, can result in duplicate claims between the instant invention and that of US Patent 6017563.

6. Claims 1-19 are free of the prior art for reasons of record delineated in Paragraph 6 in Paper No. 2 and will not be repeated in this office action.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Bhat whose telephone number is 703-308-3879. The examiner can normally be reached on Monday-Friday, 9:30AM-6: 00PM.

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The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5665.



N. Bhat
Primary Examiner
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nbl
April 9, 2000